

REMARKS

6. The Examiner objected to drawing figures 7 and 8 because they did not show processor 40. Applicants submitted replacement sheets for these drawing figures. Accordingly, applicants respectfully request that the objection to the drawing figures be withdrawn.

7. Claims 8-11 were objected to because the claim recited "Average Term" and in subsequent claims recited "Average Patent Term." Applicants have amended the claims, the specification and claims 8-11 and 53 such that all the claims now recite "Average Patent Term." Thus, because there is no longer an inconsistency in claim language, applicants respectfully request the objections to claims 8-11 and 53 be withdrawn and that these claims be allowed.

8. Claims 1-69 were rejected under 35 U.S.C. Section 112, first paragraph, because the Examiner indicated that the method could only work with assessing patents. Applicants have amended claims 1-5 such that only patents are assessed. Accordingly, applicants respectfully request that the rejection of claim 1-5 be withdrawn and that these claims be allowed.

Claim 6 has been amended and the objectionable language has been deleted and accordingly applicants respectfully request that this claim be allowed.

Claims 8-11 were rejected on the grounds that the term "may" was used, however, the application on page 16, line 5, this word is prefaced with the words "if desired." Thus, there is no need for an expert to understand this

language. Accordingly, applicants respectfully request the rejection of claims 8-11 be withdrawn.

Claims 28, 29 and 57 were rejected because the Examiner appears to indicate that for him to understand the claims would require "undue experimentation on behalf of the Examiner." Applicants do not believe that experimentation on behalf of the Examiner is an appropriate legal standard that can be used to deny the patentability of a claimed invention. Applicants respectfully request the Examiner to provide them with the legal authority for the experimentation standard that was used to deny the patentability of applicant's claims. In addition, applicants' believe that one having ordinary skill in the art would readily understand what the terms type of "industry", "level of technology" and "business activities" mean. Also, the Examiner rejected these claims on the basis of the formula component X_i . Applicants believe the claim itself, which reads "is a patent factor for the insured party selected from the group consisting of: Patent Years, Future Patent Power, Average Patent Term, CRI and Patent Strength" is quite clear. The Examiner indicates that it would take undue experimentation for him to figure out what this would require. Again, applicants do not believe that experimentation on behalf of the Examiner is an appropriate legal standard that can be used to deny the patentability of a claimed invention. Applicants respectfully request the Examiner to provide them with the legal authority for the experimentation standard used to deny the patentability of applicants' claims.

Claims 37-40 and 60-62 were rejected because the Examiner indicated there would be a problem for a method claim if the formula:

$$\mu_n = \frac{(\text{total number of structural limitations in the claims})}{(\text{total number of structural and functional limitations in the claims})}$$

if zero were to be used in the numerator. The formula is simply a portion of the invention claimed, and if data is inputted into the formula that has a result of zero, then that is merely another consideration of this claimed invention. The Examiner also objected to the Φ which is a weighting exponent that is adjusted based on the particulars of the patent or patent portfolio under study and used to adjust the value of μ_n .

$$\Phi_n = \frac{(\text{total number of words in amended claims}) \times (\text{number of amendments filed})^\lambda}{(\text{total number of words in unamended claims})}$$

where λ is a weighting exponent that is adjusted based on the particulars of the patent or patent portfolio under study"

is another formula element and is simply calculated. Again, applicants do not believe that experimentation on behalf of the Examiner is an appropriate legal standard that can be used to deny the patentability of a claimed invention. Applicants respectfully request the Examiner to provide them with the legal authority for the experimentation standard used to deny the patentability of applicants' claims.

Finally, λ is a weighting exponent that is adjusted based on the particulars of the patent or patent portfolio under study and used to adjust the value of Φ_n ; and

n represents the particular patent or patent portfolio under analysis.

This formula component is easily used by substituting a value for this symbol. Again, applicants do not believe that experimentation on behalf of the Examiner is an

appropriate legal standard that can be used to deny the patentability of a claimed invention. Applicants respectfully request the Examiner to provide them with the legal authority for the experimentation standard used to deny the patentability of applicants' claims.

With respect to claims 42-48 and 60-69, the Examiner rejected the claims because the Examiner alleges that applicant never indicates how to calculate "patent strength." However, the patent specification, page 31, first full paragraph, reads as follows:

"The present invention then performs a summation operation of the product of market strength times claim strength through the use of logic circuit 78 to obtain an average Patent Strength value for a patent n , or a patent portfolio n containing k patent claims in accordance with the following equation:

$$\text{Patent Strength} = \sum_{i=1}^k (\text{Claim Strength}_i \times \text{Market Demand}_i)$$

where k = the total number of patent claims being assessed; and

where i is a counter that ranges from 1 to k ."

And, claim 43 recites what Claim Strength is as follows:

"Claim Strength is a numerical representation of the strength of a patent claim and is calculated and adjusted using at least one of the following selected from the group comprising: Overall Adjusted Claim Ratio Index, Claim Ratio Index, Future Patent Power, Patent Years, Average Patent Term, percentage of lapsed patents in the company's patent portfolio, percentage of patent applications pending in the company's patent portfolio, percentage of patents that have been invalidated in the company's patent portfolio, percentage of patents in the company's patent

portfolio that have been involved in litigation, prior art, claim scope, validity and professional assessment;
where Market Strength is a numerical representation of the market demand for the claimed invention and is calculated and adjusted using at least one of the following selected from the group consisting of: demand for the claimed invention, future growth potential, alternate goods, substitute goods, alternate technologies, obsolescence, market timing, and other factors which tend to increase or decrease the market demand for the claimed invention; and
wherein a higher value of the Patent Strength correlates to a higher market value and wherein a lower value of the Patent Strength correlates to a lower market value.

Applicants point out that claim 43 was part of the originally filed application, and thus the originally filed application clearly sets forth what Claim Strength means. In addition, dependent claim 43 has been amended to cancel claim language drawn to other relevant factors. Claim 45 was rejected, however, claim 45 depends from claim 44, which clearly recites that the patent strength is used as a financial indicator, and claim 45 calls for the Patent Strength to be "compared to at least one of the following selected from the group consisting of: research and development expenditures, Patent Strength values for members of the company's peer group, earnings per share data, P/E ratio data, Return on Asset data and Return on Investment data." Those having ordinary skill in the art will immediately recognize the great value associated with the claimed comparisons, because well-reasoned and useful decisions can be made based on the Patent Strength values generated by the claimed invention.

Accordingly, applicants respectfully request that the 35 U.S.C. Section 112, first paragraph, rejection of claims 1-69 be withdrawn and that these claims be allowed.

7. Claims 8, 12 and 22-47 were rejected on under 35 U.S.C. Section 112, second paragraph on the grounds of a lack of antecedent basis.

Claim 7 recites company, and claim 8 which depends therefrom recites company. Applicants believe that the claim distinctly points out the claimed invention, as do dependent claims 12, 22, 23, 24-28, 29-47. If the Examiner persists in this rejection, then the applicants respectfully request further explanation.

Claims 29, 42-44 and 69 were rejected and claim 29 has been amended to provide for antecedent basis. If the Examiner persists with the rejection of claims 42-44 and 69 then applicants respectfully request further explanation.

9. Claims 1-69 were rejected under 35 U.S.C. Section 101 on the grounds of being directed to nonstatutory subject matter.

First, applicants call to the Examiner's attention the recent decision of the Board of Patent Appeals and Interferences in *Ex parte Lundgren*, No. 2003-2088; application No. 08/093,516; (Bd. Pat. App. & Inter.). This is a PRECEDENTIAL OPINION, the full text of which is publicly available on the USPTO website. This decision essentially holds that claim rejections based on a so-called "Technological Arts" test are invalid. In its decision, the Board held that "there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under [Section]

101" and the Board declined to propose to create one. Indeed, the Board went on to find that the examiner's rejection on the basis of a "technological arts" test could not be sustained.

In the present application, the Examiner similarly relies on the improper "technological arts" test to reject claims 1-69. In view of the opinion in *Ex parte Lundgren*, this rejection is improper and must be withdrawn by the Examiner. Accordingly, applicants respectfully request that the Examiner withdraw this rejection and allow claims 1-69.

The Examiner also rejected the claims under the "useful, concrete, tangible" results test, because the claims are "not credible." Applicants again respectfully disagree and for the reasons set forth above and as articulated in *Ex parte Lundgren* request that the rejection be withdrawn and claims 1-69 be allowed.

Moreover, in his Office Action dated October 13, 2005, the Examiner has relied upon and found use in the current invention. Indeed, the Examiner has used applicants' own claimed invention against them as a basis to deny the patentability of the claimed invention. For instance, on page 10, second full paragraph of the Office Action, the Examiner concluded that because the present patent application has a CRI value of 55.1, the application has a low commercial value. The mere fact that the Examiner used applicants' invention to assess applicant's application and the value thereof is a measure of proof that the claimed invention in fact has a tangible, concrete result. Indeed, the Examiner practiced the claimed invention to arrive at a concrete tangible result. Thus, because the Examiner has

already used the claimed invention as disclosed in the application, such use is a measure of proof that the invention can be practiced and a result that is predictable can be repeatably achieved, although the numerical results of the invention will vary as per the information used in the unique method claimed therein.

Thus, applicants respectfully request that the nonstatutory subject matter rejections be withdrawn and that this application and all the pending claims be allowed.

10. Claims 1-7, 48-52 and 68 were rejected under 35 U.S.C. Section 102(a) as being anticipated by Micronomics.

First, applicants' point out that the Internet is notorious for misinformation and unreliability. In addition, web pages, such as the one printed and cited to deny the patentability of applicants' claimed invention cannot be deemed reliable, since the content disclosed on web pages can be changed at any time. Applicants have a real and justifiable fear that the web pages cited by the Examiner were posted on the Internet well after their application was filed. The possibility exists that the authors of these web pages reviewed applicants' published application, which went unexamined for many years, and changed the content of their web pages accordingly. Applicants cannot reasonably be expected undertake an expensive and extensive investigation to determine when these unreliable web pages first appeared, and whether the content of these unreliable web pages was ever altered.

Accordingly, applicants respectfully request that these web pages be withdrawn as a reference to deny the patentability of applicants' claimed invention. If that is

not possible, then applicants respectfully request a formal affidavit from the Examiner made in compliance with the provisions of the Code of Federal Regulations verifying the date when these web pages first appeared on the internet, the content on that date, and the authenticity of these web pages.

In addition, for an anticipation rejection the cited reference must disclose each claim element as recited in the claim. Applicants respectfully request that Micronomics fails to anticipate the claimed invention because it fails to disclose patent strength, patent year, average patent strength, future patent power, claim ration index, adjusted claim ration index, average patent term, modification factor and other novel features of the claimed invention.

11. Claims 1-69 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Micronomics.

Applicant makes the same arguments as set forth above with respect to the unreliability of the Micronomics web pages.

In addition, for an obviousness based rejection, there has to be some teaching in the cited references that suggests the desirability of combining the references to arrive at the claimed invention. Here the Examiner combined the Micronomics article with applicants' own formulas. In particular on page 14 of the Office Action, last full paragraph, the Examiner indicates "The examiner takes Official Notice that one would have to use the exact same formulas used." Applicants respectfully request an affidavit made pursuant to the 37 C.F.R. 1.104(d)(2) Code of Federal Regulations from the Examiner wherein the

Examiner sets forth all of his personal knowledge in taking Official Notice of use of the exact same formulae. In addition, applicants are unclear as to which exact same formulas the Examiner is referring to. Is it the unique formulae in applicants' application or is it the undisclosed formulas references mentioned in the Office Action? If it is the undisclosed formulas mentioned in the Office Action, then applicants respectfully request a copy of these formulas.

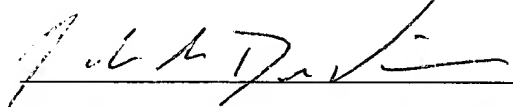
In addition, there is no suggestion provided that the Microeconomics article can combined with the math formulas the Examiner mentions to arrive at the claimed invention. Indeed, to support an obviousness rejection, the cited references must disclose each feature of the claimed invention. Here, without the formulae or references that include the unstated formulae that the Examiner mentions, it is impossible for the applicants to fully respond to these rejections.

Finally, in the first full paragraph on page 15 of the Office Action the Examiner recites a method that applicants' have claimed and combined that with Microeconomics. It appears to applicants that applicants' own claimed invention was improperly combined with Microeconomics to deny the patentability of applicants' claimed invention. Applicants do not believe that to be the standard for determining patentability. Applicants respectfully request reconsideration and that claims 1-69 be allowed.

12. Accordingly, applicants respectfully request that all of the objections and rejections be withdrawn, that all of the amendments be entered, for reconsideration, for

allowance of all the pending claims and for other favorable action.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "John M. Del Vecchio", written over a horizontal line.

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